UNITED STATES PATENT AND TRADEMARK OFFICE

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10/039,955	10/24/2001	Trevor Harms	051373-0115	8428

59555 7590 03/09/2007	EXAMINER
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>*10 November 2006*</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-25* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-25* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for

reconsideration filed on November 10, 2006. Claims 1-25 are presented for further examination.

All independent claims have been amended.

Response to Arguments

In response to Applicant's request for reconsideration filed on November 10, 2006, the

following factual arguments are noted:

a. Tafoya failed to disclose automatically entering contact information upon extraction

    into a contact list.

b. Tafoya failed to disclose that only messages sent or received before a preselected

    timestamp, after a preselected time stamp or during a preselected time period between

    two timestamps are scanned.

c. Tafoya failed to disclose presenting the extracted contact information prior to any

    storing of the extracted contact information in a user viewable information database.

In considering (a), Examiner respectfully disagrees with Applicant's argument.

Applicant contends that Tafoya failed to disclose automatically entering extracted contact

information upon extraction into a contact list since the resolution list of Tafoya is not a contact

list. Examiner disagrees with Applicant's characterization of Tafoya's resolution list. Tafoya's

resolution list contains email addresses and contacts (see inter alia Tafoya Col 4, lines 34-41).

Thus, for at least this reason Tafoya's resolution list is a contact list.

Applicant also contends that Tafoya teaches away from automatically entering extracted contact information upon extraction since "to hypothetically and alternatively automatically enter extracted contact information upon extraction into the contact list of Tafoya would eliminate Tafoya's resolution list" (Applicant response November 10, 2006 pg 8, last ¶). This argument is moot since Examiner does not purpose any such modification. Under the current rejection rationale contact information is automatically entered into Tafoya's resolution list and not his contact list.

In considering (b), Examiner respectfully disagrees with Applicant's argument. Applicant contends that Tafoya failed to disclose that only messages sent or received before a preselected timestamp, after a preselected time stamp, OR during a preselected time period between two timestamps are scanned. Foremost Examiner notes that the above limitations are linked with the conjunction OR and thus Tafoya must only teach one of these limitations. Furthermore, at the very least Tafoya only scans message sent or received after a preselected time stamp. For instance Tafoya only performs an initial scan upon the program starting and from that point forward only scans new messages while the program is still open (see inter alia Tafoya Col 9, lines 51-63). The point after which the initial scan is completed represents the logical timestamp or point in time where messages after the point are dynamically scanned as they are received. Applicant should note that the current claims do not require scanning based on timestamps specifically associated with each message. For example, the claims only require scanning after a preselected timestamp. Examiner maintains that the point after which the initial scan is completed clearly represents a logical timestamp for dynamic scanning to begin and thus

can be properly equated with Applicant's limitation requiring scanning *after a preselected time stamp*.

Applicant asserts that this rationale fails to properly address the claim limitation since when the user restarts the program another initial scan will be preformed. Examiner respectfully disagrees with this logic. Tafoya's dynamic scanning function is preformed until the user takes further action, such as by closing the program and then reopening it again. This clearly represents at least one period of time where messages are only scanned *after a preselected time stamp* and thus anticipates the limitation.

Applicant also asserts that Tafoya's system updates the contact list from scanning unsent messages, such as when the user enters an email address, and thus cannot only scan messages sent or received after a time of last scan. While Tafoya's system can perform such functionally, Examiner notes that Tafoya clearly disclosed at least one embodiment where only sent or received messages scanned to order to ensure the validity of the email addresses (see inter alia, Col 10, lines 1-12).

In considering (c), Examiner agrees that the amendments have overcome the prior art of record however the claims are not yet allowable in view of the outstanding 112 1st ¶ written description rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 4-5, 12-15 and 21-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

With regard to claims 4-5, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular Applicant failed to disclose scanning only messages sent or received before a pre-selected time stamp. Applicant also failed to disclose scanning only messages sent or received during a pre-selected time period between time stamps. In the sole portion of Applicant's specification where time stamps are discussed Applicant recites the following in ¶ 38: "Scanning messages since a certain time stamp, such as since the last scan time or only scan new messages. The time stamp can be automatically updated on each scan.". This portion of the specification clearly fails to disclose scanning before a certain point in time. Moreover it also fails to disclose scanning between two time stamps. Clearly scanning only new messages is not the same as scanning messages between two pre-selected time points. Thus, Applicant failed to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claims 12-15 and 21-24, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, Applicant's specification failed to describe a *means for presenting the extracted contact information from a plurality of the number of messages at once*

on the portable device prior to any storing of the extracted contact information in a user

viewable information database. When information is extracted electronically in a computer, the

information must be stored in some type of memory in order for the information to be retained.

Hence, in the context of Applicant's invention, the extracted contact information must be stored

in some form before it can be presented. Applicant's specification clearly disclosed presenting

extracted contact information to the user for the user's review and modification prior to the

information being stored in the user's contact list. However, prior to the step of storing contact

information in the user's contact list, Applicant is silent regarding how and where the extracted

contact information is stored. Thus Applicant failed to describe that the information is *not* stored

in a user viewable information database. In other words, Applicant failed to describe storing the

extracted contact information in a non-user viewable database as the claim language inherently

requires in view of the language requiring presentation of the data *prior to any storing of the*

extracted contact information in a user viewable information database. Thus, Applicant failed

to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-11, 16-20, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by

Tafoya et al. (U.S. Patent Number 6,829,607; hereinafter Tafoya).

With regard to claims 1 and 16, Tafoya disclosed a method for populating a contact list (e.g. address book or resolution list) on a portable device (e.g. hand-held device, Col 5, lines 24-28), the method comprising:

- ❑ Extracting contact information from a number of messages stored in a memory in the portable device (e.g. initially populating the resolution list, see inter alia Col 7, lines 9-54); and

- ❑ Automatically entering the extracted contact information into a contact list (e.g. resolution list) maintained by a program operating on the portable device (see inter alia Col 7, lines 9-54) (for operating on the portable device see Col 5, lines 23-33)

- ❑ Wherein the existing contact information is modified with the extracted information or is replaced with the extracted information (see inter alia, Col 9, lines 53-56).

With regard to claims 2 and 17, Tafoya disclosed extracting contact information includes monitoring incoming messages and retrieving contact info information from incoming messages (dynamically update the resolution list, Col 9, lines 59-63).

With regard to claim 3, Tafoya disclosed contact information includes an SMTP email address (Col 7, line 51).

With regard to claims 4 and 18, Tafoya disclosed extracting contact information includes scanning a message database and retrieving contact information from messages contained in the database (e.g. initially populating the resolution list, see inter alia Col 7, lines 9-54).

With regard to claim 5, Tafoya disclosed only message sent or received after a pre-selected time are scanned (e.g. after the program is started only new entries are dynamically scanned, Col 9, lines 51-63).

With regard to claim 6, Tafoya disclosed only messages sent or received after a time of a last scan are scanned (e.g. after the program is started only new entries are dynamically scanned, Col 9, lines 51-63).

With regard to claims 7 and 19, Tafoya disclosed entering the extracted contact information into a contact list maintained by a program operating on the portable device includes providing a GUI with contact information configured to receive a selection from a user of the portable device (see inter alia, Col 11, lines 42-54).

With regard to claims 8 and 20 Tafoya disclosed automatically entering in the contact list only contact information not already contained in the contact list (Col 10, lines 13-17).

With regard to claims 9 and 10, Tafoya disclosed filtering contact information to include

or exclude from the contact list contact information from emails and retrieved addresses received

from certain domains (Col 11, lines 9-22).

With regard to claim 11, Tafoya disclosed filtering contact information to include in the

contact list only email sender information (Col 8, lines 10-26).

With regard to claim 25, this claim is rejected using similar rationale as applied to claims

1 and 6.

Conclusion

The prior art made of record, in PTO-892 form, and not relied upon is considered

pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 5, 2007

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SUPERVISORY PATENT EXAMINER